

REMARKS

This Amendment responds to the Decision on Appeal dated January 16, 2009.

The Board of Patent Appeals and Interferences (Board) reversed the Examiner's rejections of all pending claims under 35 U.S.C. § 101, holding that the claims were in fact directed to statutory subject matter. The Board, however, upheld the Examiner's prior art rejection of claims 41, 42, 44-49, and 54. The Board also issued new grounds for rejecting claims 1, 15, 29, and 50. Claims 41-46 have been canceled.

When providing a new basis for rejecting claims 29 and 50, the Board examined the applicant's claim limitation that the information stored in a respective UUID/Metadata Box provide "interactivity" with the image. The final rejection, from which the applicant's appeal was taken, did not find this limitation in the cited prior art. The Board, however, held that this limitation was disclosed in the cited JPEG 2000 disclosure by taking a reading of the term "interactivity" more expansive than the applicant intended, or that the Examiner had originally interpreted the term. Specifically, though the applicant's specification describes the claimed interactivity with an image in terms of interactivity between *a user* and the image, the Board interpreted the term to include interactivity between the UUID/metadata box and the image as a whole. *See* Board Decision at p. 17, first paragraph ("We find data in a JP2 file is interactive with the rendered image. For example, the resolution data . . . and the rendered image are interactive – the data and the image act with each other to produce the image in the proper resolution for that particular image.")

Although the applicant parenthetically disagrees with the logic of the Board, as it seems circular to content that the image itself can be interactive with metadata so as to render the image

in the first place, the board's interpretation is not what is contemplated by the applicant when using the term "interactive."

Independent claims 1 and 15 have each been amended to recite the limitation of "wherein said information provides user-interactivity with said image." This limitation narrows the claim to what the applicant intended by the phrase "interactivity", and distinguishes over the functionality of the JP2 file that the Board contends is "interactive." As the Examiner had previously indicated that this limitation distinguished over the prior art, claims 1 and 15 should therefore now be allowable.

Dependent claims 5, 7, 19, and 21 have been amended to each recite additional features regarding the claimed interactivity that further distinguish over the cited prior art.

Similarly, independent claims 29 and 47 have been amended to recite the limitations of information or data that "provides user-interactivity interactivity with said image, said user-interactivity comprising at least one of: (i) defining a boundary around a portion of said image that said user may interact with; (ii) providing voice annotation associated with a user-selectable region of said image; and (iii) defining a boundary around a user-selectable portion of said image." These claims, as well as each of their respective dependent claims therefore distinguish over the cited prior art for the same reasons as do claims 1 and 15.

Appl. No. 09/882,416
Amdt. dated January 27, 2009
Reply to the Decision on Appeal of January 16, 2009

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-3, 5-17, 19-31, 33-40, and 47-59.

Respectfully submitted,

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Dated

Kurt Rohlfs

Kurt Rohlfs

Reg. No. 54,405

Tel No.: (503) 227-5631